

REMARKS

This paper is filed in response to the non-final official action dated May 17, 2007. This paper is timely-filed, as it is accompanied by a petition for an extension of time to file in the first month and authorization to charge our deposit account no. 13-2855 the requisite extension fee of \$460.00.

Claims 1-24 are pending. By the foregoing, claims 25-29 have been added. The Commissioner is authorized to charge our deposit account in the amount of \$250 for 5 additional claims in excess of 20. Support for new claims 25-29 may be found, for example, at page 5, lines 13-14. No new matter has been added.

Claims 1-6, 10, 12-15, and 19-24 have been rejected under 35 U.S.C. § 102(b) as anticipated by European Patent Publication No. 0 549 145 to Fasano ("Fasano EP").

Claim 7 and 16 have been rejected under 35 U.S.C. § 103(a) as obvious over Fasano EP in view of U.S. Patent No. 5,236,987 to Arendt ("Arendt"). Claims 8, 9, 17, and 18 have been rejected under 35 U.S.C. § 103(a) as obvious over Fasano EP in view of either U.S. Patent No. 4,243,417 to Grouke ("Grouke") or U.S. Patent No. 4,283,320 to Carroll ("Carroll"). Claim 11 has been rejected under 35 U.S.C. § 103(a) as obvious over Fasano EP in view of U.S. Patent No. 5,418,013 to Detrick ("Detrick"). Additionally, claims 1-6, 10, 12-15, and 19-24 have been rejected under 35 U.S.C. § 103(a) as obvious over Fasano EP.

Applicants note that the rejections set forth in paragraph 12 (page 11) are substantially duplicative of those set forth in paragraph 7 (page 5). Similarly, the rejections set forth in paragraph 13 (page 12) are substantially duplicative of those set forth in paragraph 8 (page 6). Again, the rejections set forth in paragraph 14 (page 13) are substantially duplicative of those set forth in paragraph 9 (page 7). Clarification is requested.

Claims 1-6, 10-15, 23, and 24 have been rejected under 35 U.S.C. § 103(a) as obvious over Detrick in view of U.S. Patent Publication No. 2002/0103283 to Elfring ("Elfring"). Claims 7 and 16 have been rejected under 35 U.S.C. § 103(a) as obvious over the combination of Detrick and Elfring further in view of U.S. Patent Publication No. 2002/0151648 to Fasano ("Fasano US"). Claims 8, 9, 17, and 18 have been rejected under 35 U.S.C. § 103(a) as obvious over the combination of Detrick and Elfring further in view of U.S. Patent No. 4,032,491 to Schoenke ("Schoenke").

The bases for the claim rejections are addressed below in the order presented in the official action. Reconsideration of the application is solicited in view of the following remarks.

CLAIM REJECTIONS – 35 U.S.C. §102

Claims 1-6, 10, 12-15, and 19-24 have been rejected as anticipated by European Patent Publication No. 0 549 145 to Fasano EP. The applicants respectfully traverse the rejections.

It is well-established that each and every limitation of a claimed invention must be present in a single prior art reference in order for anticipation to occur. *See*, for example, *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998). The standard for anticipation is one of strict identity. Such a standard has not been satisfied here.

Fasano EP teaches paint compositions including a “transient colorant” (such as a pH indicator) to increase the wet hiding power of paints. Fasano further teaches that:

Most preferred wet paints are aqueous-based paints with a titanium dioxide content of less than 20% by weight, based on the weight of the wet paint: at titanium dioxide levels greater than about 20% by weight, wet hiding power is usually sufficiently high.

See Fasano EP at page 3, lines 25-28. In contrast, all pending claims recite “titanium dioxide in an amount from about 20 weight percent to about 60 weight percent.”

The aforementioned ranges merely touch; they do not overlap in any way. Ranges that merely touch do not provide a sufficient basis for anticipation. In support of this assertion, the examiner is directed to *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 1000 (Fed. Cir. 2006). *Atofina* stands for the proposition that claims are anticipated only when the claimed subject matter is disclosed in a reference with “sufficient specificity.” *Id.* at 999. The *Atofina* court held that no reasonable fact finder could determine that the overlap of a disclosed range of 0.001 to 1.0 percent was anticipated by a disclosed range of 0.1 to 5.0 percent. *Id.* The court further held a disclosure does not anticipate a range when it does not disclose the endpoints of that range. As set forth above, Fasano EP merely discloses one endpoint that touches the claimed range. Accordingly, Fasano EP does not disclose the endpoints of the claimed range, and anticipation cannot be found as a matter of law.

For the foregoing reasons, the applicants respectfully submit that the anticipation rejections of claims 1-6, 10, 12-15, and 19-24 over Fasano EP should be withdrawn.

CLAIM REJECTIONS – 35 U.S.C. §103(a)

All pending claims 1-24 have been rejected variously rejected as variously obvious over Fasano EP alone or in further view of Arendt, Grouke, Carroll or Detrick. Additionally, claims 1-18, 23, and 24 have been rejected variously rejected as variously obvious over the combination of Detrick and Elfring by itself or in further view of Fasano US or Schoenke. The applicants respectfully traverse the rejections.

Rejections Based on Fasano EP

As previously indicated, Fasano EP teaches including a “transient colorant” (such as a pH indicator) in paint compositions to increase their wet hiding power. Fasano EP also teaches that “at titanium dioxide levels greater than about 20% by weight, wet hiding power is usually sufficiently high.” Accordingly, Fasano EP teaches that there is *no benefit* to increasing the titanium dioxide content of paint compositions containing a transient colorant to be “in an amount from about 20 weight percent to about 60 weight percent,” as recited by all claims. Therefore, one of ordinary skill in the art would not be motivated to modify the paint compositions disclosed in Fasano EP to have greater titanium dioxide contents, and the obviousness rejections of claims 1-24 over Fasano EP cannot be maintained whether Fasano EP is taken alone or in view of the other cited documents (which were not cited for their teachings regarding titanium dioxide contents).

Furthermore, in further support of the non-obviousness of all pending claims, the applicants respectfully submit that Fasano EP actually teaches away from the claimed invention. “A *prima facie* case of obviousness may . . . be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.” MPEP 2144.05; *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997); *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1322 (Fed. Cir. 2004). As previously discussed, the object of Fasano EP is to increase the wet hiding power of paint compositions. Because Fasano EP teaches that “at titanium dioxide levels greater than about 20% by weight, wet hiding power is usually sufficiently high,” Fasano EP teaches against compositions comprising “titanium dioxide in

an amount from about 20 weight percent to about 60 weight percent,” as claimed. This is particularly true since Fasano EP explains that “in many paints only low levels of scattering pigments are used, primarily for economic reasons.” *See* Fasano EP at page 2, lines 17-18.

It is respectfully submitted that an obviousness rejection based upon a reference that specifically teaches against the claimed invention is manifestly improper, and should not be made.

The *In re Woodruff* and *Titanium Metals* decisions referenced by the examiner are inapplicable here for at least the aforementioned reasons.

Accordingly, the obviousness rejections based on Fasano EP should be removed.

Rejections Based on Detrick and Elfring

The applicants respectfully submit that Detrick and Elfring do not disclose or suggest a color changing correction fluid comprising titanium dioxide in an amount from about 20 weight percent to about 60 weight percent, as recited by all claims.

Detrick teaches including a transient colorant in a coating composition so as to provide a strongly visible light-absorptive colorant which thereby decreases the drying time of the coating when exposed to incident light. *See* Detrick at column 1, lines 11-16 and column 2, lines 50-61. Detrick does not teach a composition comprising titanium dioxide in an amount from about 20 weight percent to about 60 weight percent, as recited by all pending claims. Accordingly, the examiner turned to Elfring.

Elfring teaches an exterior coating composition having improved long term solar reflectance. *See* Elfring at paragraph 1. Such an improved coating composition is achieved by *reducing* the content of the inorganic additives therein by substituting a specific solid, particulate organic polymer therefor. *See* Elfring at paragraphs 18 and 19. Elfring discloses that “inorganic additives are conventionally present in an amount of from 10% to 90% by weight of the *total solids* in the composition” (*see* Elfring at paragraph 40) whereas all pending claims recite “titanium dioxide in an amount from about 20 weight percent to about 60 weight percent.”

The examiner's characterization of "inorganic additives are conventionally present in an amount of from 10% to 90% by weight of the *total solids* in the composition" as "the use of 10-90% titanium dioxide" (*see* the official action at page 14) is wholly without technical merit. Rather, this disclosure that the examiner relied upon as showing the claimed range is a relative disclosure — and its meaning can only be determined relative to the total amount of solids in the composition. Notably, Elfring does not specifically disclose ranges for the total amount of solids in its coating compositions.

Further, there is no basis for construing the aforementioned disclosure to mean that titanium dioxide is the only inorganic additive in the coating composition. In this regard, the examine is directed to the disclosure at page 4, paragraph 39, which discloses that inorganic additives includes both pigments such as titanium dioxides and fillers such as calcium carbonate "to fill the composition."

The only true disclosure concerning titanium dioxide content in Elfring is found in its examples, and these examples do not show compositions having "titanium dioxide in an amount from about 20 weight percent to about 60 weight percent," as recited by all claims. Accordingly, the proposed combination does not teach or suggest all of the claim limitations and a *prima facie* case of obviousness cannot be established.

The other cited documents do not address this deficiency, but rather were cited as assertedly disclosing certain features present in various dependent claims. Accordingly, the various obviousness rejections of claims 1-18, 23, and 24 over Detrick and Elfring have been overcome and should be withdrawn.

NEW CLAIMS 25-29

New claims 25-29 are patentable for at least the reasons provided above.

CONCLUSION

It is submitted that the application is in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, she is respectfully invited to contact the undersigned attorney at the indicated telephone number.

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Respectfully submitted,



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